

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE F. MARCKINI

Appeal No. 97-3671
Application 08/266,977¹

ON BRIEF

Before MARTIN, BARRETT, and LEE Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 8-15. Claims 1-7 have been canceled. No claim has been allowed.

References relied on by the Examiner

Pfost et al. (Pfost)	4,020,325	Apr. 26, 1977
Milnes	4,587,410	May 06, 1986
Clark	4,636,622	Jan. 13, 1987
Langhans et al. (Langhans)	5,500,513	Mar. 19, 1996

¹ Application for patent filed June 27, 1994. Assigned to Polaroid Corporation.

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The Rejections on Appeal

Claims 8-15 stand finally rejected under 35 U.S.C. § 103. In the answer, the examiner did not expressly state the basis of the ground of rejection. We assume that the rejection is rendered on the basis of Milnes, Langhans, Clark and Pfof.

The Invention

The invention is directed to a method for effecting selective access to events or transactions. Access to the events or transactions being restricted by both identity and a predetermined number of permissible access. The sole independent claim on appeal is reproduced below:

8. An access system for determining access to an event or transaction for a bearer of a data holding article, the bearer having a personal identifier, access to the event or transaction being dependent on the satisfaction of predetermined bearer identification requirements and the existence of prior occurrences, the method employing the data holding article and an information processing apparatus; the method comprising the steps of

providing a data holding article, the data holding article having recorded thereon machine-readable data, the machine-readable data including encoded data representative of a bearer's personal identifier, the machine-readable data including encoded data representative of at least one event or transaction, each event or transaction having a predetermined number of permissible occurrences;

providing information processing apparatus, the information processing apparatus having means for reading the encoded event-related or transactional data, the information

processing apparatus having means for reading the encoded personal identifier data, the information processing apparatus having input means for receiving a personal identifier presented by the bearer, the presented personal identifier being correspondent with the encoded personal identifier data, the information processing apparatus having means for computing correlation between the encoded personal identifier data and the presented personal identifier;

presenting the data holding article to the information processing apparatus, the information processing apparatus reading the encoded personal identifier data, the information processing apparatus reading the encoded event-related or transactional data for a determination of prior occurrences;

presenting the bearer's personal identifier to the information processing apparatus, the information processing apparatus computing the correlation between the presented personal identifier and the encoded personal identifier data for a determination of bearer identity; and

a) the information processing apparatus effecting a bar to the event or transaction when the correlation between the presented personal identifier and the encoded personal identifier data is inconsistent with the predetermined bearer identification requirements or when there is a determination that access would exceed the predetermined number of permissible occurrences, and

b) the information processing apparatus effecting access to the event or transaction when the correlation between the presented personal identifier and the encoded personal identifier is consistent with the predetermined bearer identification requirements and when there is a determination of prior events or transactions within the predetermined number of permissible occurrences, the information processing apparatus altering the data holding article to record the access, the recordation being machine-readable by the information processing apparatus for the determination of prior occurrences.

Opinion

We reverse.

A reversal of the examiner's rejection should not be construed as an affirmative indication that the subject matter claimed is patentable over prior art, even over the prior art references cited by the examiner. We focus only on the statements, positions, and rationales presented by the examiner and do not undertake to examine the claims ab initio.

A. Findings of Fact

1. The rejection of claims 8-15 as was stated on page 2 of the final Office action (Paper No. 8) **was not** stated in the examiner's answer as a ground of rejection.

2. The examiner's answer **does not** clearly state any ground of rejection except to note that the following four references have been relied on: Milnes, Langhans, Clark, and Pfof.

3. The final Office action (Paper No. 8) states on page 2 thereof that claims 1-15 are rejected under 35 U.S.C. § 103 as being unpatentable over the prior art **as set forth previously** and further in view of Beck and Langhans.

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4. The Office action dated September 18, 1995 (Paper No. 6) states that claims 1-15 are rejected under 35 U.S.C. § 103 as being unpatentable over the prior art **as set forth previously** with the addition of LeStrange and/or Milnes.

5. The Office action dated March 13, 1995 (Paper No. 4) states that claims 1-15 are rejected under 35 U.S.C. § 103 as being unpatentable over the prior art **cited herewith and that cited by applicant**.

5. The Office action of March 13, 1995, included a Form 892 listing 5 references, including 2 United States patents and 3 foreign references.

6. On June 27, 1994, the applicant filed a Form 1449 listing 9 references, including 7 United States patents and 2 domestic articles.

7. On the Form 1449, the examiner indicated that he considered the listed references on February 22, 1995.

8. Although a total of 18 references evidently were applied by the examiner, at one time or another, during the prosecution history leading up to and including the final Office action, the examiner's answer listed and referred to only four references Milnes, Langhans, Clark, and Pfost.

9. It is not at all clear what is the actual ground of rejection beyond that the claims have been rejected as being obvious over a combination of references. It is not known how each reference is relied on for which features of the invention, and even which specific references have been relied on.

B. Discussion

The examiner characterizes the appellant's argument pointing out the deficiencies of the examiner's position in making out a prima facie case of obviousness as "essentially denies 35 USC 103" and "a common and transparent evasive tactic" (see answer at page 5). We disagree. Obviousness is not presumed, but must be established by the examiner by a preponderance of the evidence. There is nothing "evasive" about pointing out the lack of specificity and lack of meaningful discussion by the examiner with regard to the applied prior art. To the contrary, that is precisely what an appellant should do, provided that the assertions are true, as here.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to

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support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one with ordinary skill in the art would have been led to modify or combine prior art references to arrive at the claimed invention. Such reasons must stem from some teaching, suggestion, or implication in the prior art as a whole or knowledge generally possessed by one with ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See, e.g., In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The failure to clearly state and present the ground of rejection as we have found above alone constitutes a sufficient ground for reversal. In the context of an obviousness rejection under 35 U.S.C. § 103, the examiner has an affirmative duty, under Graham v. John Deere, 383 U.S. at 17, 148 USPQ at 467, to make underlying factual findings including the scope and content of the prior art, and the differences between the applied prior art and the claimed invention. The lack of specificity deprives the appellant of a suitable rebuttal and makes the rejection vague and uncertain on review. Absent sufficient findings, it cannot be said that the examiner has sufficiently made out a prima facie case of obviousness.

Alternatively, we assume that the examiner withdrew the ground of rejection asserted in the final Office action and entered a new ground of rejection in the examiner's answer relying only on Milnes, Langhans, Clark, and Pfoest. However, although in this presumed setting the identity of the references is no longer unclear, the rejection is still nonetheless unsupported by sufficient factual findings regarding the scope and content of the prior art and the

differences between the claimed invention and the prior art. With regard to the first three paragraphs of claim 8, the examiner's analysis is merely this: "See Figs. 7 and 8 and col 16, line 63 of Langhans and col. 1, lines 30-56 of Milnes (especially the reference [in Milnes] to Pfof) as discussed above." The lack of specificity equates to a mere invitation for the reader to apply Milnes in some way. It is unknown what the examiner had in mind with regard to each feature recited in the first three paragraphs of claim 8.

In any event, we have read the cited portions of the references and have found several deficiencies in each for meeting the claimed invention. Nothing is readily apparent from Langhans with regard to storing in the customer's card encoded data representative of an event or transaction having a predetermined number of permissible occurrences. Nothing is readily apparent from Milnes or Pfof with regard to the storing of a personal identifier on the parking card of Milnes.

Also, with regard to clauses (a) and (b) in claim 8, the features of the invention requiring selective access based on **both** the user identifier and the checking of consistency with

a predetermined number of permissible occurrences of the event or transaction, **and** an altering of the data holding article to record an access, have not been adequately accounted. The following explanation by the examiner on page 5 of the answer does not set forth how the above-noted features of the claimed invention are met by Milnes, Langhans, Clark, and/or Pfoest:

The prior art systems are obviously programmed to either bar or grant based upon their verification parameters. Note that both Langhans (col. 6, line 41) and Clark (col.2, line 50) read coded card data and a separate "personal identifier", i.e. a PIN number or a fingerprint, respectively.

It should be noted that the mere fact that the prior art may be modified in a manner to arrive at the appellant's claimed invention does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc., 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 117 S.Ct. 80 (1996).

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For the foregoing reasons, we do not sustain the rejection of claims 8-15 under 35 U.S.C. § 103 over the examiner's applied prior art or otherwise presumably over Milnes, Langhans, Clark, and Pfof.

Conclusion

The examiner's rejection of claims 8-15 under 35 U.S.C. § 103 as being unpatentable over certain applied references, or alternatively, over Milnes, Langhans, Clark and Pfof, is reversed.

REVERSED

JOHN C. MARTIN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LEE E. BARRETT))
Administrative Patent Judge)	APPEALS AND
)	
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